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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,929	04/02/1999	CHARLES MCELFFRESH	22499-701	4307

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EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/18/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/285,929

Applicant(s)

MCELFRESH ET AL.

Examiner

Stephen S. Hong

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/35/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 9-18, 27-35 and 51-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19-26 and 36-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 9-18, 27-35, 51-73 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 23.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: RCE and amendment filed on March 25, 2004 to the application, filed on April 2, 1999; prior art, filed March 25, 2004.
2. Claims 1-73 are pending in the case. Elected claims 1-8, 19-26 and 36-50 are addressed on merits in this office action.
3. The rejection of claims 1-8, 19-26 and 36-50 under 35 U.S.C. 103(a) as being unpatentable over Markowitz et al., U.S. Pat. No. 6,311,185 B1, 10/01 in view of Cannon, U.S. Pat. No. 6,286,005 B1, 9/01 and in view of the Applicant's admitted well known prior art, on page 1-3 of the specification has been withdrawn in view of the amendment.

#### *Specification*

4. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-8, 19-26 and 36-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz et al., U.S. Pat. No. 6,311,185 B1, 10/01 in view of Aggarwal et al, U.S. Pat. No. 6,714,975 B1 and in view of the Applicant's admitted well known prior art, on page 1-3 of the specification.

As per claims 1-8, 19-26 and 36-50, Markowitz discloses the following claimed features:

storing and retrieving performance data associated with the likelihood of the event occurring for each object and prioritizing the objects on the page according to the performance data (col.3, line 2, "A history database 210 can be consulted...when selecting the advertisement"); and the performance data includes the user's characteristics and profiles (col.3, lines 1-17, "...the user's age, sex and hobbies...demographic database...");. Although Markowitz does not explicitly disclose the pay-per-click type of advertisement payment by the advertisers, as Applicant points out (on page 2 of the specification) such was extremely well known practice in the WWW advertisement, and thus would have been obvious to a person of ordinary skill in the art at the time of the invention.

Furthermore, Markowitz teaches the rearrangement of the advertisements on the page to provide an effective advertisement (col.4, line 20-45, "...advertisements.. could be positioned above and below the text.."). However, Markowitz does not explicitly point out that the rearrangement of the advertisement is based on the user statistics and/or profiles, and the rearrangement is done relative to one another. Nevertheless, this feature is taught by the prior art of Aggarwal. Aggarwal teaches "dynamically assigning advertisements to web pages according to self-learned user information

(col.1, line 11). In the prior art, Aggarwal teaches “dynamically placing objects in slots on a web page in response to a current client request for the web page (col.2, line 56)” and that “the advertisement slot...size and location is also taken account during the real-time assignment process (col.9, line 42).” Specifically, Aggarwal teaches that “the impact of different slot sizes and locations on click/exposure” is considered for the arrangement (col.3, line 63). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Aggarwal’s feature into Markowitz, since Aggarwal taught the benefit of allowing the “optimizing placement of advertisements and scheduling of the web pages (col.1, line 45)” for the prospective user.

*Response to Arguments*

Applicant's arguments with respect to claims 1-8, 19-26 and 36-50 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen Hong  
Primary Examiner  
Art Unit 2178  
June 14, 2004